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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re. Appellant: Thomas C. Mielenhausen
Serial No.: 09/309,831
Filed: May 11, 1999
For: DATA PROCESSING APPARATUS AND METHOD FOR CONVERTING
WORDS TO ABBREVIATIONS, CONVERTING ABBREVIATIONS TO
WORDS, AND SELECTING ABBREVIATIONS FOR INSERTION INTO
TEXT
Examiner: Cong Lac T. Huynh
Art Unit: 2178
Confirmation No.: 8013
Attorney: Nelson R. Capes
Attorney
Docket No.: 33197.8
Additional Fees: Charge to Deposit Account 023732

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL COVER LETTER

Enclosed for filing please find the following:

1. Appellant's Reply Brief Under 37 C.F.R. § 41.41 (4 pgs.);
2. Postcard receipt.

Respectfully submitted,

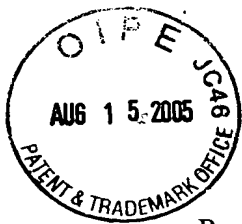
Dated: 8/12/05

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By Nelson R. Capes
Date 8/12/05



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Sir:

APPELLANT'S REPLY BRIEF

This Reply Brief is submitted under 37 CFR 41.41 to the Examiner's Answer mailed June 29, 2005.

CERTIFICATE OF MAILING

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By Nelson R. Capes
Date 8/10/05

I. ARGUMENT

A. The Examiner is using the incorrect Rule regarding grouping of claims.

In item (7), the Examiner states that the claims stand or fall together under 37 CFR 1.192(c)(7). This section of the Rules has been replaced by 37 CFR 41.37, which does not require the Appellant to group claims. Rather, it requires the Appellant to respond to each ground of rejection separately under a separate heading:

(vii) Argument. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

Appellant has complied with the new Rule and has argued several claims separately under separate headings.

B. Grounds of Rejection

Although the Examiner's Answer does not appear to contain any new ground of rejection, it does appear that the Examiner has added additional explanation for certain grounds of rejection:

1. Regarding claim 1, the Examiner now states that:

Goldwasser discloses...the fact that highlighting, sounding beeps, or pronouncing the characters of abbreviations whenever the user neglects to use the abbreviation for a word in the text keypressed by the user shows that said word is selected to be converted into a corresponding abbreviation; the stored words and their corresponding abbreviations in Goldwasser used for the converting purpose as mentioned also implies that when said memory is first created, a word in the text, which is can be [*sic*]any kind of text in reality, is selected to be converted into a corresponding abbreviation by the creator.

In addition to the arguments already made in the Appeal Brief, Appellant respectfully disagrees. Claim 1 expressly requires selecting a word in the text to be converted to a corresponding abbreviation as a separate step from creating the list of words and corresponding abbreviations, which latter step would be done by the creator.

2. In regard to claims 3-6, the Examiner has changed his position since the Final Office Action.

The Answer states:

Regarding claims 3-6, Applicants argue that Ichbiah only converts abbreviations to words, not vice-versa, and therefore, does not teach converting words to abbreviations. Examiner respectfully disagrees.

However, in the Final Office Action, page 8, paragraph 2, the Examiner agreed with Appellants' position.

As Appellants have not had an opportunity to counter this argument, even though it is not expressly designated by the Examiner as a new ground of rejection, Appellant requests the Board to disregard the Examiner's changed position.

3. The Examiner's Answer in regard to claim 13 is moot.

The Examiner argues (in Response to Arguments) that he "does not agree completely" that his statements are self-contradictory.

It is moot whether or not the Examiner agrees completely. Appellants re-iterate that such self-contradictory statements are not productive and indeed harmful to developing a consistent position in the record for Appeal.

4. The Examiner's position is incorrect in regard to claim 15.

In Response to Arguments, the Examiner states that:

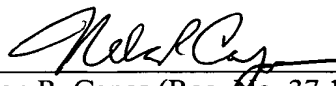
"said argued limitation does not require selecting an abbreviation from the first data structure as in claim 13 that Applicants consider allowable subject matter. Therefore, Applicants' arguments are not persuasive."

Appellants disagree. Claim 15 includes the step (d) of "the user instructing the data processing method to select an abbreviation from the list." This is substantially the same as the limitations of claim 13.

For the above reasons, Appellant respectfully requests the Board to overturn the Examiner's rejections and allow the claims under appeal.

Respectfully submitted,

Dated: 8/10/2005

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